

REMARKS/ARGUMENT

I. General Remarks.

Claims 1-39 are pending in the present application. Claims 1-39 are rejected. Claims 1-3, 14, and 25 are amended herein for clarity rather than patentability reasons. Claim 29 has been cancelled. Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein.

II. Remarks Regarding Double Patenting Rejection.

A. Applicants Petition to Withdraw Previously Submitted Terminal Disclaimer.

The Examiner has rejected claims 1-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,796,378 B2 (hereinafter "*Reddy*"). Applicants previously had filed a timely Terminal Disclaimer, with the appropriate fee, along with a prior Response, to overcome this rejection. In the Second Office Action, the Examiner indicated that this Terminal Disclaimer was being held in abeyance, pending evaluation by PTO personnel of the propriety of the Examiner's rejection. In the Response to the Second Office Action, Applicants requested withdrawal of the previously filed Terminal Disclaimer. In the Third Office Action, the Examiner failed to address this issue, despite Applicants' request for withdrawal while the Terminal Disclaimer was being held in abeyance. The Examiner then requested in the Fourth Office Action that the Applicants must petition to withdraw the terminal disclaimer because it had already been approved. Applicants have submitted a Petition to withdraw the Terminal Disclaimer and the appropriate fee with this response, and respectfully request that it be granted.

B. Present Claims Are Not Obvious Over Reddy, and Therefore, Should Not Be Rejected Under Obviousness-Type Double Patenting.

Applicants respectfully assert that the Examiner has not shown *Reddy* to obviate claim 1, because, *inter alia*, the Examiner has not shown *Reddy* to disclose a method of cementing that comprises "activating the cement composition," as required by Applicants' claim 1. Nowhere does *Reddy* teach the step of "activating the cement composition."

The Examiner has stated that water acts in "activating" the cement composition. (Final Office Action at 8.) Applicants respectfully disagree because water does not "activate" the Applicants' cement compositions in the manner that the present application specifies. The

specification of the present application states that the cement composition may be made ready for use by the addition of activator compositions that “generally comprise a mixture of at least one alkali or alkaline earth metal hydroxide, and a trialkanolamine.” (Specification, ¶ [0027]) Reddy does not teach this method of activation.

Furthermore, in the Response to Fourth Office Action, Applicants provided data indicating that the addition of water to a cement slurry has been shown to increase thickening time, *e.g.* retard cement setting. The data indicated that increasing the amount of water in a slurry increases the thickening time, even at varying temperatures. One of ordinary skill in the art would also deduce from the data that simply adding water would not “activate” a cement composition, as the Examiner so claims.

Furthermore, In the Response to Fourth Office Action, Applicants asked the Examiner to provide evidence that refutes the argument that water does not “activate” a composition. However, the Examiner has yet to provide any evidence that water does, in fact, act as an activator. Applicants have provided evidence that the addition of water does not “activate” a composition. “If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2). *See* also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. *See* 37 CFR 1.104(d)(2).” MPEP 2144.03(C) The Examiner has not shown that the addition of water is necessary to activate a cement composition.

For the foregoing reasons, the present claims do not constitute double patenting over *Reddy*.

III. Remarks Regarding Rejections of Certain Claims Under 35 U.S.C. § 112, 2nd Paragraph.

A. Rejection of Claim 1 Pertaining to Activation of the Cement Composition.

The Examiner has rejected claim 1 as vague and indefinite “because the cement composition cannot be activated without water.” (Final Office Action at 3.) Notwithstanding Applicants’ arguments above, Applicants have amended claim 1 to include water in the cement

composition as per the Examiner's preference. (See Section II.B.) Applicants respectfully request that this rejection be withdrawn, and earnestly solicit a timely Notice of Allowance for these claims, and claims that depend therefrom.

B. Remarks Pertaining to a Previous Rejection Regarding the Term "High" Density Particles.

The Examiner states that "[t]he terms 'high' density particles are definite term in claim 7. The applicants define this term on page 20 of their specification as meaning *particles that are heavier than the setttable fluid to which the particles are to be added.*" (Final Office Action at 4.) (emphasis added) Since the Examiner has agreed that this term is definite, and does not appear to have maintained this rejection in the Final Office Action, Applicants believe this rejection to have been withdrawn, and respectfully request confirmation of the same.

C. Rejection of Claims 14 and 25 Pertaining to the Term "Desired."

The Examiner has rejected claims 14 and 25 as indefinite for use of the term "desired." (Final Office Action at 4.) For the reasons stated in the Response to Fourth Office Action, Applicants respectfully maintain that this language is sufficiently definite to comply with 35 U.S.C. § 112. However, Applicants have amended claims 14 and 25 per the Examiner's preference. Applicants respectfully request the withdrawal of the rejection hereunder against claims 14 and 25, and earnestly solicit the timely issuance of a Notice of Allowance for these claims.

IV. Remarks Regarding Rejections of Claims 1-39 Under 35 U.S.C. §§ 102/103.

The Examiner has rejected claims 1-39 under 35 U.S.C. 102 (a and b) as anticipated by U.S. Patent No. 6,089,318 to Laramay et al. ("*Laramay*"), U.S. Patent No. 6,172,147 to Abelleira et al. ("*Abelleira*"), U.S. Patent No. 6,087,418 to Yamashita et al. ("*Yamashita*"), U.S. Patent No. 5,016,711 to Cowan ("*Cowan '711*"), U.S. Patent No. 5,275,654 to Cowan ("*Cowan '654*"), U.S. Patent No. 5,298,070 to Cowan ("*Cowan '070*"), U.S. Patent No. 6,402,832 to Vijayendran ("*Vijayendran*"), U.S. Patent No. 5,112,603 to Nadolsky et al. ("*Nadolsky*"), U.S. Patent No. 4,393,939 to Smith et al. ("*Smith*"), U.S. Patent No. 3,508,407 to Booth ("*Booth*"), CN 1385388 to Lu et al. ("*Lu*"), JP2000191350 to Tobori et al. ("*Tobori*"), JP 09020536 to Tamura et al. ("*Tamura*"), JP06128001 to Mizunuma et al. ("*Mizunuma*"), JP 05043293 to Koizumi ("*Koizumi*"), JP 61256956 to Yamaguchi et al. ("*Yamaguchi*"), JP 59109663 to Takenaka Komuten Co. ("*Takenaka Co.*"), and DE 3213799 to Borchardt et al.

(“*Borchardt*”), known collectively as the “Cited References.” Alternatively, the Examiner has rejected claims 1-39 under 35 U.S.C. 103 as obviated by the Cited References alone or in view of U.S. Patent No. 5,588,488 to Vijn et al. (“*Vijn*”) or U.S. Patent No. 5,672,203 to Chatterji et al. (“*Chatterji*”).

A. The Cited References Do Not Anticipate or Obviate The Present Claims.

Applicants respectfully point out to the Examiner that Applicants’ independent claim 1 includes the step of activating a cement composition, and that the Examiner has not shown that any of the Cited References disclose the step of activating the cement composition, which is expressly required by Applicants’ claim 1. The Examiner states that “[w]ater is the activating agent for a cement composition and all cement compositions must contain water to activate the hydraulic properties and lead to a settable material. All of the prior art references teach adding water to their cement composition and thus teach ‘activating’ their cement composition.” (Final Office Action at 5.) Applicants respectfully disagree.

Claim 1, as amended, recites “a cement composition comprising a hydraulic cement, a set retarder, water, and a particle-size distribution-adjusting agent comprising a cationic polymer.” Claim 1 also recites the step of “activating the cement composition.” None of the Cited References alone or in combination teach these limitations.

For any of the references cited to anticipate Applicants’ independent claim 1 under 35 U.S.C. §102(b), the reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Applicants respectfully assert that none of the references have been shown to teach the step of activating the cement composition, and thus the Examiner has failed to show that any of these references teaches or suggests every element of Applicants’ independent claim 1. Moreover, as discussed above in Section II.B., the addition of more water to a cement slurry has been shown to increase thickening time, *i.e.* retard cement setting. Accordingly, Applicants respectfully submit that none of these References has been shown to anticipate Applicants’ independent claim 1.

Furthermore, in addition to not teaching the step of “activating the cement composition,” Applicants also submit the following with regard to the Cited References:

- *Laramay* is directed to a fluid loss control agent (*Laramay*, Abstract) and does not teach a “particle-size distribution-adjusting agent comprising a cationic polymer.”

- *Albelleira* is directed to masonry cement compositions “used for bonding bricks, blocks, and other masonry units.” (*Albelleira*, 1:10-14) *Albelleira* does not teach the limitation “placing the cement composition in a subterranean formation from which hydrocarbons are removed,” as recited by amended claim 1. Furthermore, *Albelleira* also does not teach a “particle-size distribution-adjusting agent comprising a cationic polymer.”
- *Yamashita* is directed to cement compositions comprising polymeric admixtures that contributes to fluid retainability and fluidity of the cement composition (*Yamashita*, Abstract, 1:6-11) and “conventional cement dispersants” (*Yamashita*, 15:34-16:41)(emphasis added). *Yamashita* does not teach a “particle-size distribution-adjusting agent comprising a cationic polymer,” as recited by Applicants’ amended claim 1.
- *Vijayendran, Nadolsky, Lu, Tabori, Tamura, Mizunuma, Koizumi, Yamaguchi, and Takenaka Co.* do not teach the limitation “placing the cement composition in a subterranean formation from which hydrocarbons are removed,” as recited by amended claim 1. Applicants respectfully submit that the present application is directed to subterranean formations from which hydrocarbons are removed. Support for this can be found throughout the Specification, for example in paragraphs [0002], [0003], and [0037]. Thus, the references have not been shown to be relevant.
- *Smith and Borchardt* are directed to clay stabilizing agents comprising cationic polymers that affect formation permeability and do not teach a “particle-size distribution-adjusting agent comprising a cationic polymer.”
- *Booth* does not teach the limitation “placing the cement composition in a subterranean formation from which hydrocarbons are removed,” as recited by amended claim 1. *Booth* also does not teach the inclusion of a set retarder. The Examiner states that “it is notoriously

known in the art to add a retarder to any cement to delay setting.” (Final Office Action at 9.) Applicants respectfully disagree and submit that the addition of a retarder to the cement composition in *Booth* is not obvious to one of ordinary skill in the art. *Booth* is directed to backfilling mines, in which there is no realistic need for a retarder. Accordingly, to obviate the subject claims, *Booth* must teach or suggest compositions that comprise retarders, or other compounds that inherently or expressly constitute retarding agents. *Booth* discloses none of these. Furthermore, the Examiner provides no reference stating that cement compositions for backfilling mines would necessitate the addition of a retarder.

Because the Examiner has not shown that any of these references either in alone or in combination teach all limitations of claim 1, Applicants respectfully request that the rejection of claims 1 based upon these references be withdrawn, and respectfully request that this claim be allowed. Since claims 2-39 depend from claim 1, and therefore incorporate all limitations of claim 1, claims 2-39 similarly should be allowed.

Should a rejection based on these assertions be maintained, Applicants respectfully request evidentiary support. If the Examiner is relying upon “common knowledge” or “well known” principles to supply the motivation to combine, Applicants request that a reference be provided in support of this position pursuant to MPEP § 2144.03. Alternatively, if the Examiner’s personal knowledge is being relied on to supply the disclosure of the motivation to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to MPEP § 2144.03 and 37 C.F.R. § 1.104(d)(2).

B. The Cited References In View Of *Vijn* Or *Chatterji* Do Not Obviate Claims 1-39.

The Cited References in view of *Vijn* or *Chatterji* do not obviate claims 1-39 of the present application. As discussed previously in Section IV.A., none of the Cited References teach a step of activating the cement composition. Nor can *Vijn* or *Chatterji* be used to supply this missing recitation. The Examiner relies on *Vijn* and *Chatterji* for the teaching of a retarder (Final Office Action at 5.) Accordingly, the Cited References in view of *Vijn* or *Chatterji* do not teach the step of “activating the cement composition” as recited in claim 1, and thus, do not disclose or suggest every element of independent claim 1.

Therefore, independent claim 1 is not obviated by the Cited References in view of *Vijn* or *Chatterji*. The remaining rejected claims depend either directly or indirectly on independent claim 1. All these dependent claims, which include all the limitations of their corresponding independent claim, are allowable for at least the reasons cited above with respect to independent claim 1. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-39.

V. No Waiver.

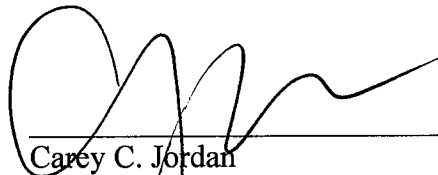
All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the Cited References. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants have authorized the Commissioner to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0359, for any cost associated with the following: (1) RCE under 37 C.F.R. § 1.17(e)(\$790.00), and (2) Petition to Withdraw Terminal Disclaimer under 37 C.F.R. § 1.17(f)(\$400.00). Applicants believe that there are no additional fees due in association with this filing of this Response. However, should the Commissioner deem that any fees are due, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0359.

Respectfully submitted,



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